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| 09/555,951 | 09/05/2000 | Lester Andrew Evans | RJENK14.001A | 8225 |

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EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/555,951 | Applicant(s) EVANS ET AL. | |
| | Examiner Gerald Gauthier | Art Unit 2645 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 April 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23-37 and 42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 32-34 is/are allowed.
- 6) Claim(s) 23-31, 35-37 and 42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Regarding **claim(s) 32**, the word "if" in lines 12, 15 and 18, renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim(s) 33 and 34 are rejected for being dependent of **claim(s) 32**

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claim(s) 23-27, 35 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini (US 5,987,317) in view of Sahni et al. (US 5,646,986).

Regarding **claim(s) 23**, Venturini discloses a method of providing a mailbox answerphone service (column 4, line 50 "messages") to a caller (column 4, line 51 "users") in a mobile communications system (34a on FIG. 2) during a call (column 7, line 14 "PBX responds") directed to a directory number used commonly by different subscribers to access their mailboxes, wherein the answerphone service is located in a first network and is responsive to calls originating from within the first network and from within a second network connected to the first network via international telecommunications links, the method (column 1, lines 6-8), comprising:

providing an identification code (column 8, line 29 "the access code") identifying a mailbox (column 8, line 34 "mailbox") associated with a subscriber (column 8, line 46 "user") through an answerphone service (column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice messages from the voice mailbox]; and

entering a first mode of answerphone operation for a call originating from within the first network (column 8, line 52 "for a case the message is transmitted to the public network") and a second, different mode of answerphone operation for a call originating from within the second network, wherein the answerphone service enters either the first or the second mode of operation in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal].

Venturini discloses a first mode of answering operation from within the network but fails to disclose a second mode of the answering service for an international call.

However, Sahni teaches an answering service with two modes operations local and international (column 7, lines 36-50).

Therefore it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Venturini using the teaching of answering service with two mode as taught by Sahni.

The modification of the invention would offer the capability of having a second mode of the answering service for an international call so that the system would save the user long distance charges.

Regarding **claim(s) 24**, Venturini discloses in the first mode of operation, if the call is not diverted, providing a message retrieval service, and if the call is diverted, providing a message deposit service (column 7, lines 12-23).

Regarding **claim(s) 25**, Venturini discloses determining whether the call is diverted using information received during call establishment (column 7, lines 24-35).

Regarding **claim(s) 26**, Venturini discloses providing in the second mode of operation either a message deposit service or a message retrieve service in dependence of a receipt of a selection indicator from the caller during the call (column 7, lines 36-41).

Regarding **claim(s) 27**, Venturini discloses in the second mode prompting the caller, after inputting the identification code during the call, for a voice message to be received and stored, and providing the message retrieve service if the indicator is received from the user (column 8, lines 29-48).

Regarding **claim(s) 35**, Venturini discloses a method of providing a mailbox answerphone service (column 4, line 50 “messages”) to a caller (column 4, line 51 “users”) in a mobile communications system (34a on FIG. 2) during a call (column 7, line 14 “PBX responds) directed to a directory number used commonly by different subscribers to access their mailboxes, wherein the answerphone service is located in a first network and is responsive to calls originating from within the first network and from within a second network connected to the first network via international links, wherein the answerphone service is configured to enter a first mode of answerphone operation for a call originating from within the first network and a second, different mode of answerphone operation for a call originating from within the second network, the method (column 1, lines 6-8), comprising:

identifying, through an answerphone service (column 8, line 30 “the network”), a mailbox (column 8, line 34 “mailbox”) associated with a subscriber identification code (column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice messages from the voice mailbox]; and

entering either the first mode or the second mode of answerphone operation (column 8, line 52 “for a case the message is transmitted to the public network”) in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal].

Venturini discloses a first mode of answering operation from within the network but fails to disclose a second mode of the answering service for an international call.

However, Sahni teaches an answering service with two modes operations local and international (column 7, lines 36-50).

Therefore it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Venturini using the teaching of answering service with two mode as taught by Sahni.

The modification of the invention would offer the capability of having a second mode of the answering service for an international call so that the system would save the user long distance charges.

Regarding **claim(s) 42**, Venturini discloses a voice processing system for a mobile communications system, wherein the voice processing system is located in a first network and is responsive to calls originating from within the first network and from within a second network connected to the first network by international telecommunications links, wherein the voice processing system is configured to enter a first mode of answerphone operation for a call originating from within the first network and a second, different mode of answerphone operation in response to a call originating from within the second network, wherein the voice processing system is (column 1, lines 6-8) adapted to identify a mailbox (column 8, line 34 "mailbox") associated with a subscriber (column 8, line 46 "user") by way of an identification code (column 8, line 29 "the access code") processed through an answerphone service (column 8, lines 29-48) [The mobile terminal 10 user dials the access code with a request to retrieve the voice messages from the voice mailbox], and to enter either the first mode of answerphone

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operation (column 8, line 52 “for a case the message is transmitted to the public network”) or the second, different, mode of answerphone operation in dependence on information received during call establishment indicating whether the call is of international origin (column 8, lines 29-48) [The mobile switch network retrieves the voice messages from the mailbox and transmit to the mobile terminal].

Venturini discloses a first mode of answering operation from within the network but fails to disclose a second mode of the answering service for an international call.

However, Sahni teaches an answering service with two modes operations local and international (column 7, lines 36-50).

Therefore it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Venturini using the teaching of answering service with two mode as taught by Sahni.

The modification of the invention would offer the capability of having a second mode of the answering service for an international call so that the system would save the user long distance charges.

8. **Claim(s) 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Sahni as applied to claim(s) 26 above, and further in view of Hulen et al. (US 5,497,373).

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Regarding **claim(s) 28**, Venturini in combination with Sahni as applied to **claim(s) 26** differs from **claim(s) 28**, in that it fails to disclose the indicator comprises a DTMF tone.

However, Hulen teaches the indicator comprises a DTMF tone (column 7, lines 37-40).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the indicator comprises a DTMF tone of Hulen in the invention of Venturini in combination with Sahni.

The modification of the invention would offer the capability of the indicator comprises a DTMF tone such as the equipment user would define their own service application.

9. **Claim(s) 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Sahni as applied to claim(s) 23 above, and further in view of Kennedy, III et al. (US 5,539,810).

Regarding **claim(s) 29**, Venturini in combination with Sahni as applied to **claim(s) 23** above differs from **claim(s) 29** in that it fails to disclose prompting the caller for the identification code.

However, Kennedy teaches prompting the caller for the identification code if the identification code is otherwise not associated with the call when received (column 11, lines 33-38).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use prompting the caller for the identification code of Kennedy in the invention of Venturini in combination with Sahni.

Doing so would request an identification code.

Regarding **claim(s) 30**, Kennedy teaches wherein the identification code corresponds to a directory number of the subscriber (column 11, lines 17-19).

10. **Claim(s) 31, 36 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Venturini in view of Sahni as applied to claim(s) 23 and 35 above, and further in view of Wilson et al. (US 5,838,772).

Regarding **claim(s) 31** Venturini as applied to claim(s) 23 differs from claim(s) 31 in that it fails to disclose identifying a call of international origin through an international origin indicator in signaling associated with the call.

However, Wilson teaches identifying a call of international origin through an international origin indicator in signaling associated with the call (column 7, lines 44-51).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Venturini use prompting the caller for the identification code as taught by Kennedy.

Doing so the system would request an identification code so that the user would access its mailbox.

Regarding **claim(s) 36**, Wilson teaches deriving the origin of the call using information received during call establishment (column 8, lines 31-38).

Regarding **claim(s) 37**, Wilson teaches using the common directory number by all subscribers to access the answerphone service (column 7, lines 44-46).

Response to Arguments

11. Applicant's arguments with respect to **claim(s) 23-37 and 42** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**GERALD GAUTHIER
PATENT EXAMINER**

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December 12, 2005

Gerald Gauthier
Examiner
Art Unit 2645


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